

REMARKS

Favorable consideration and allowance are respectfully requested for claims 14-31 in view of the foregoing amendments and the following remarks.

The rejection of claim 30 as failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph, is respectfully traversed. The Office Action asserts that the limitation "wherein none of the electrodes are auxillary electrodes" is not supported by the original disclosure.

First, it is important to consider that the law does not require word-for-word copying of claim language in order for a claim to be properly supported. As articulated by the Federal Circuit Court of Appeals, *ipsis verbis* disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question. *In re Edwards*, 568 F.2d 1349, 1351-52, 196 U.S.P.Q. 465, 467 (CCPA 1978), See also *Fujikawa v. Wattanasin*, 93 F.3d 1559, 39 U.S.P.Q.2d 1895 (Fed. Cir. 1996). In other words, the question is whether the application provides adequate direction to reasonably lead persons skilled in the art to the claimed subject matter. See *In re Edwards* at 1352, 196 U.S.P.Q. at 467.

Second, the Patent and Trademark Office has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize a description of the claimed invention in the original disclosure. See the Manual of Patent Examining Procedure, Section 2163(II)(A)(3)(b), U.S. Department of Commerce, Patent and Trademark Office, Eighth Edition, August 2001. This burden has clearly not been met. To date, the only evidence or reasoning in the record is a conclusory statement offered in the recent Office Action that the cited claim limitation "is not supported by the original disclosure and one of ordinary skill in the art would not have appreciated that [sic] such an arrangement based on the original written description." This assertion is

provided without any support or explanation, and can certainly not be said to meet the requirement of explaining why a person skilled in the art would not recognize a description of the claimed invention in the original disclosure. Rather, the Office Action merely presents a conclusion.

Finally, reviewing the specification as a whole, it is clear that the Applicants had possession of the invention as claimed. Paragraph [0007] specifically explain that in previously known cells, auxiliary electrodes or special multilayer electrodes are necessary for proper charge balancing. Paragraph [0008] then indicates that an object of the invention is to achieve charge balancing in the negative electrodes. With the invention, charge balancing (the function of the auxiliary electrodes in the known battery cells) is achieved with the negative electrodes. Therefore, the auxiliary electrodes are superfluous and no longer necessary. A person of skill in the art would understand this language in the specification to indicate that the inventor's contemplated a battery cell where the construction and arrangement of negative electrodes replaces the need for auxiliary electrodes, and these auxiliary electrodes are not provided in the cell.

Paragraph [0008] also makes clear that the inventors considered it important to minimize the resource outlay for constructing these cells. Eliminating extra parts generally reduces the materials costs for the cells. The present invention makes auxiliary electrodes superfluous. Given the goal of reducing costs, one of skill in the art would clearly understand that the inventors contemplated a cell without these superfluous auxiliary electrodes.

Accordingly, the claim amendment does not present new matter and reconsideration and withdrawal of this rejection are respectfully requested.

The rejection of claims 14-16 and 30-31 under 35 U.S.C. § 102(b) as anticipated by van Ommering (U.S. Patent No. 4,115,630) is respectfully traversed.

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Reply dated January 19, 2005
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Claim 14 has been amended to include the limitations of previously pending claim 15. Claim 15 has been cancelled without prejudice or any disclaimer of the subject matter therein. Claims 14, 30 and 31 require, among other things, that the two outermost electrodes are negative electrodes which are each flanked by one transport element. van Ommering does not teach or suggest that the two outermost electrodes are negative electrodes which are each flanked by a transport element.

Claim 16 has been amended to included the limitation of claim 17. The Office Action indicated that claim 17 would be allowable if presented in independent form, including the limitations of the base claim and any intervening claims. Accordingly, claim 16 should now be in allowable form.

Reconsideration and withdrawal of the rejection are respectfully requested.

The rejection of claims 18-29 under 35 U.S.C. § 103 as obvious over van Ommering, in view of various references, is traversed. Each of these claims is dependent, either directly or indirectly, on claim 14. As indicated above, van Ommering fails to teach each and every element of claim 14. The other various references similarly fail to teach the missing elements of claim 14. Indeed, these other references are not cited against claim 14. Accordingly, claims 18-29 are not obvious over the cited combinations of references. Reconsideration and withdrawal of these rejections are respectfully requested.

CONCLUSION

In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

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If there are any questions regarding this response or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #080449.50806US).

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'CT McWhinney', written over a horizontal line.

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